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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,262	10/04/2000	Geoffrey B. Rhoads	60304	7124
23735	7590	01/09/2004	EXAMINER	
DIGIMARC CORPORATION 19801 SW 72ND AVENUE SUITE 100 TUALATIN, OR 97062			THOMPSON JR, FOREST	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/679,262

Applicant(s)

RHOADS, GEOFFREY B.

Examiner

Forest Thompson Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to applicant's arguments filed 07/16/2003 (see Paper #6). Applicant argues the rejection of claims 1-11 in reference to the prior art used in the First Action (see Paper #5) filed 07/16/03. Claims 1-11 are pending.
2. Claims 1-11 have been examined.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Perkowski (U.S. Patent No. 5,950,173).

Claim 10. Perkowski discloses:

- scanning machine-readable indicia on a tag associated with a garment (col. 6 lines 12-20);
- decoding multi-bit data from said scanned indicia (col. 6 lines 12-20);

- through use of at least a portion of said multi-bit data, identifying clothes or accessories that may complement said garment (col. 21 lines 18-27).

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloomberg et al. (U.S. Patent No. 5,765,176), and further in view of Shkedy (U.S. Patent No. 6,260,024).

Claim 1. Bloomberg discloses:

- providing a printed catalog that includes an image of an article offered for sale by a merchant, the image is steganographically encoded with plural-bit binary data (Abstract; col. 3 line 28 – col. 5 line 16);
- optically sensing the image to produce image data corresponding thereto (col. 3 lines 28-35; col. 29 lines 13-22);
- decoding the steganographically encoded data from the image data (col. 4 lines 13-31; col. 29 lines 13-22); and
- electronically ordering the article from the merchant by use of said decoded data (col. 2 lines 26-42; col. 28 lines 40-51).

Bloomberg does not explicitly disclose said ordering makes use of earlier-stored customer profile information. However, Shkedy teaches said ordering makes use of

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earlier-stored customer profile information (col. 12 line 56 – col. 13 line 44). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the disclosure of Bloomberg to explicitly teach said ordering makes use of earlier-stored customer profile information, as disclosed by Shkedy, for the motivation of facilitating electronic commerce between buyers and a seller.

Claim 2. Neither Bloomberg nor Shkedy explicitly discloses the customer profile information includes clothing size data. However, Shkedy does explicitly teach providing selected buyer information to the seller (col. 12 line 56 – col. 13 line 44). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the disclosure of Bloomfield to explicitly teach providing selected buyer information to the seller, as disclosed by Shkedy, for the motivation of facilitating electronic commerce between buyers and a seller.

Claims 3, 4, 5: Bloomberg discloses:

- processing the decoded data for transmission to a remote computer, said processing including supplementing the decoded data with supplemental data corresponding to the customer (col. 28 lines 40-51); and
- transmitting the processed data to remote location (col. 2 lines 26-42); and
- receiving first order from the remote location or merchant, responsive to the transmitted processed data, and presenting the first order data to the customer (col. 30 line 46 –col. 31 line 8).

Bloomberg does not explicitly disclose transmitting the processed data to the remote merchant computer; receiving from the user further input selecting among options included in the first order data; the supplemental data includes the customer profile information; the supplemental data includes data identifying the customer; nor transmitting said further input to the remote merchant computer. However, Shkedy discloses transmitting the processed data to the remote merchant computer; receiving first order data from the remote merchant computer, responsive to the transmitted processed data; presenting the first order data to the customer; receiving from the user further input selecting among options included in the first order data; the supplemental data includes the customer profile information; the supplemental data includes data identifying the customer; and transmitting said further input to the remote merchant computer (col. 5 line 7 – col. 8 line 15). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the disclosure of Bloomberg to explicitly disclose transmitting the processed data to the remote merchant computer, receiving from the user further input selecting among options included in the first order data, the supplemental data includes the customer profile information, the supplemental data includes data identifying the customer, and transmitting said further input to the remote merchant computer, as disclosed by Shkedy, for the motivation of facilitating electronic commerce.

Claim 6. Bloomberg discloses:

- providing a printed catalog that includes an image of an article offered for sale by a merchant, and machine-readable indicia representing multi-bit data associated with said article (Abstract; col. 3 line 28 – col. 5 line 16);
- optically sensing the indicia to produce image data corresponding thereto (col. 3 lines 28-35; col. 29 lines 13-22);
- decoding the multi-bit data from the image data (col. 4 lines 13-31; col. 29 lines 13-22); and
- transmitting at least a portion of said multi-bit data to a first computer (col. 2 lines 26-42),
- transmitting data from the first computer to a second computer, said data serving to identify the article (col. 2 lines 26-42); and
- presenting selection data from the second computer to a user (col. 28 lines 4-29).

Bloomberg does not explicitly disclose transmitting data identifying the user to a first computer; said selection data representing at least one of (a) colors, (b) styles and (c) sizes associated with said article; nor receiving input from the user selecting among the presented selection data, and transmitting same to the merchant. However, Shkedy discloses:

- transmitting data identifying the user to a first computer (col. 13 line 62 – col. 14 line 6);
- said selection data representing a particular item from a selected category, with a description of the goods entered by the buyer (col. 13 lines 7-44), which encompasses at least one of (a) colors, (b) styles and (c) sizes associated with said article; and

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- receiving input from the user selecting among the presented selection data, and transmitting same to the merchant (col. 13 line 7 – col. 14 line 29).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the disclosure of Bloomberg to explicitly disclose said selection data representing at least one of colors, styles and sizes associated with said article, receiving input from the user selecting among the presented selection data, and transmitting same to the merchant, as disclosed by Shkedy, for the motivation of facilitating electronic commerce.

Claim 9. Bloomfield discloses transmitting selection data from the second computer to a user computer (col. 30 line 46 – col. 31 line 8).

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bloomberg et al. (U.S. Patent No. 5,765,176), and further in view of Shkedy (U.S. Patent No. 6,260,024) and O'Neill et al. (U.S. Patent No. 6,219,653).

Claim 7. Neither Bloomberg nor Shkedy disclose consulting earlier-stored user profile data, nor customizing the selection data presented to the user in accordance with said profile data. However, O'Neill et al. discloses consulting earlier-stored user profile data, and customizing the selection data presented to the user in accordance with said profile data (col. 2 lines 42-63). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the disclosures of Bloomberg and



Shkedy to explicitly consult earlier-stored user profile data, and customize the selection data presented to the user in accordance with said profile data, as disclosed by O'Neill et al., for the motivation of facilitating electronic commerce.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bloomberg et al. (U.S. Patent No. 5,765,176), and further in view of Shkedy (U.S. Patent No. 6,260,024) and Official Notice.

Claim 8. Bloomberg does not explicitly disclose sensing the indicia with a peripheral device that includes an optical sensor and a wireless link to an associated processing device. Bloomberg does disclose sensing the indicia with a peripheral device. Official Notice is taken that a peripheral device that includes an optical sensor and a wireless link to an associated processing device that can be used to scan/detect indicia was old and well known in the technological arts at the time the invention was made. A common use of such a device was for reading indicia of articles on shelves in stores for the purpose of inventorying on-hand stock or compiling a shopping list. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the disclosures of Bloomberg and Shkedy to explicitly sense the indicia with a peripheral device that includes an optical sensor and a wireless link to an associated processing device, as disclosed by old and well known art, for the motivation of facilitating electronic commerce.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perkowski (U.S. Patent No. 5,950,173) and further in view of Kawahara et al.; "Virtual Fitting Room with Spoken Dialog Interface;" Department of Information Science, Kyoto University (printed in IPSJ Journal vol. 39, no. 05, 1995-1999).

Claim 11. Perkowski discloses presenting at least certain of said clothes or accessories to a user on a display screen, using a fashion model that also includes said garment (col. 21 lines 18-27). Perkowski does not specifically disclose a synthesized model. However, Kawahara et al. discloses presenting at least certain of said clothes or accessories to a user on a display screen, using a synthesized model that also includes said garment (pg. 3 section 3.1). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the disclosure of Perkowski to explicitly disclose using a synthesized model that also includes said garment, as disclosed by Kawahara et al., for the motivation of facilitating electronic commerce.


### ***Conclusion***

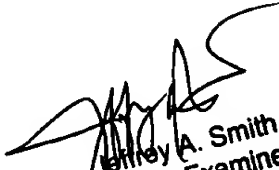
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson Jr. whose telephone number is (703) 306-5449. The examiner can normally be reached on 6:30 AM-3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

FT   
05 January 2004

  
Jeffrey A. Smith  
Primary Examiner